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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,526	12/05/2000	Eduardo Ramirez de Arellano	LOSAS-0000	7475
24496	7590	10/23/2003	EXAMINER	
PATENT LAW OFFICES OF HEATH W. HOGlund			PARKER, FREDERICK JOHN	
256 ELEANOR ROOSEVELT STREET			ART UNIT	
SAN JUAN, PR 00918			PAPER NUMBER	

1762

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/730,526	Applicant(s) DE ARELLANO, EDUARDO RAMIREZ	
	Examiner Frederick J. Parker	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 21-24 is/are rejected.
- 7) ☒ Claim(s) 8-13,25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Specification

The amendments in response to the New Matter Objections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objections.

Claim Rejections - 35 USC § 112

The amendments in response to the 35 USC 112/ New Matter rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections. The new rejections are required by amendment and Applicants reply to the non-responsive communications.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 7 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the original claims and specification of hardening "to prevent scoring lines". Applicants cannot utilize negative limitations without express basis in the claims to overcome a reference, Ex parte Grasselli, 231 USPQ 393.

3. Claim 24 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original claims and specification do not appear to cite the limitations of new claim 24 citing

hardening to prevent impressions and pattern formation. The Examiner also points out that the reply to the non-responsive (page 12) also fails to point out support for the new limitations.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1,3-5 ,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiffer in view of Valle et al.

Schiffer and Valle et al are cited for the same reasons discussed in the previous Office Action., which are incorporated herein. Applicants arguments and the Declaration filed 9/22/03 have been carefully considered.

The Declaration by the inventor attests to the criticality of drying on using a rough trowel to smooth a concrete mortar applied in a layer approximately 1 cm thick. The Examiner understands and appreciates the information provided by the declaration. At the outset, however, the Examiner points out that no claim deals with the thickness values discussed in the Declaration. Further, independent claims 1,7 and 21 simply require removing “an exterior portion” of a mortar/accelerant/water mixture applied to a concrete surface after a prescribed drying period. Those independent claims never require use of a smooth or rough or, for that matter, ANY type of trowel. Thus, The Declaration is not commensurate in scope with the claims. Regarding new claim 26, it does contain the critical aspects of drying set forth in the Declaration, although no coating thickness is cited. The Declaration has raised the issue of the criticality of coating thickness, and this issue must be addressed on the record.

The limitations of independent claims 1,7 and 21 simply require removing “an exterior portion” of a mortar/accelerant/water mixture applied to a concrete surface after a prescribed drying period are clearly met by the combination of references of Schiffer in view of Valle et al. As clearly shown in the figure of Schiffer, the removed portions which form the scoring indentations are only a surface phenomenon and the figures show a significant portion of sub-surface material remaining. The cementitious mortar necessarily must be partially set to allow maintenance of the removed portion without slumping or dripping into the removed areas. No reformation or re-distribution of material is required. Claim 1 alone cites “forming an even surface”, then only in the preamble and never in the steps of the claim, but the Examiner points out that the common use of the term “even” can simply mean “equally matched or balanced” (Webster’s II Riverside Dictionary 1994), the figure of Schiffer showing a balanced and equally matched indentation pattern such that the final surface would also be reasonably called “even”. As to Applicants argument that Schiffer requires the coating to be partially set but not dry, the Examiner is at a loss to see how this differs from Applicants requirements because if Applicants layer was entirely dry (which clearly would not take place in the claimed time frames), removal by trowel as Applicant argues would be impossible. Finally Applicants argument is directed to use of a rough trowel which is not commensurate in scope with independent claims 1,7,21.

Applicants do not further argue the rejection of claims 3-5 , 22-23 and therefore those rejections stand. The prior art does not teach hardening to prevent scoring lines of claim 7 or to prevent impressions or formation of patterns of claim 24; however, these are deemed new matter, and claims 7 and 24 are accordingly rejected above.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiffer in view of Valle et al and further in view of APA.

Schiffer, APA and Valle et al are cited for the same reasons discussed in the previous Office Action, which are incorporated herein. Claim 6 is not argued with respect to the additional references cited in the rejections, and therefore the rejections are maintained.

4. Claims 2,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiffer in view of Valle et al and further in view of Nishida et al.

Schiffer, Nishida et al and Valle et al are cited for the same reasons discussed in the previous Office Action, which are incorporated herein.

As to claim 2, Nishida et al expressly cites aggregate particles up to 300 microns/ 0.3mm (overlapping the range of “particles greater than 0.18 mm in diameter”). Since both Schiffer and Nishida et al teach similar compositions, and Schiffer is silent as to specific aggregate sizes, the teachings of the aggregate grain sizes of Nishida et al would have provided criteria for aggregate sizes useful for similar compositions. Thus, there is simply no “teaching away” from the claims, but rather simply overlapping ranges. The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made if the overlapping portion of the particle size ranges disclosed by the reference were selected because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Wortheim* 191 USPQ 90. The rejection of claims 2,22 are accordingly maintained.

5. Claims 25-26 distinguish over the prior art which does not teach to use a rough trowel (as per 200 as shown in drawings) to scrape only the exterior skin of the composition sufficiently hardened according to the limitations of claims 25-26. Claims 7-13 and 24 are allowable over the prior art for reciting preventing scouring lines and preventing impressions/ patterns, but these are deemed to be New Matter above; cancellation of the New Matter will require reinstatement of previous rejections of claims 7-13 and cancellation of claim 24. Claims 8-13, 25 are objected to for depending from a rejected base claim.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

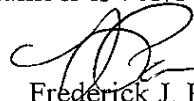
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 703/308-3474. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703/308-2333. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0661.


Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp